

## **Remarks/Arguments**

### **A. Status of the Specification**

The specification is revised to correct translation errors that occurred during the translation of the French specification into the English language. For instance, “acorn” is replaced with “chuck” at page 5, line 11, of the English specification. This amendment is also consistent with the language used at page 1, lines 20-24.

Additionally, the phrase “as well as both mineral and mineral” is replaced with “as well as both mineral and organic” at page 7, line 29, of the English specification. Applicant refers the Examiner to page 8, lines 5-6, of the French language PCT application for support, which recites “ou encore a la fois de nature minerale et **organique...**” (emphasis added).

### **B. Status of the Claims**

Claims 19-21, 25, 28, and 44 are revised, claim 35 is cancelled, and claims 45-46 are added. Non-limiting support for the revisions to claim 19 can be found in the English translated specification at page 5, lines 17-19 and 22-25. Non-limiting support for the revisions to claims 20-21, 25, 28, and 44 can be found in the specification at page 3, lines 13-20. Non-limiting support for new claim 45 can be found in the specification at page 5, line 32, to page 6, line 2. Non-limiting support for new claim 46 can be found in the specification at page 9, lines 8-11.

In view of these amendments, claims 19-34 and 36-46 are pending, with claims 23-24 and 44 currently withdrawn from consideration.

### **C. Interview Summary**

Applicant’s representative, Michael Krawzsenek, and Examiner Robinson discussed claim 19 in view of the cited Ohlin reference on March 25, 2010. During this interview, Examiner Robinson indicated that if claim 19 were revised to state that the temporary protective

layer covers the surface of the lens in such an amount that “provides sufficient adhesion of the lens to a holding pad during edging of the lens,” then the anticipation rejection would likely be removed but that an additional search would have to be performed. Examiner Robinson also cautioned that such an amendment would have to meet the written description requirement of 35 U.S.C. § 112, first paragraph. As noted above, support for this limitation can be found in the specification at page 5, lines 17-19 and 22-25.

Applicant appreciates the Examiner’s time in conducting this interview.

**D. The Written Description and Indefiniteness Rejections Are Moot**

As suggested at page 4 of the Action, the relevant dependent claims have been revised to recite “the outermost layer of the temporary protective coating.” The current written description and indefiniteness rejections are believed to be moot and should be withdrawn.

**E. The Anticipation Rejection in View of Ohlin Should Be Withdrawn**

Claims 19, 20, and 33-36 remain rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,792,537 (“Ohlin”).

Although Applicant respectfully disagrees (see previous response), it is noted that claim 19 has been revised in a manner discussed above in the Interview Summary. This amendment, which states that the temporary protective layer “provides sufficient adhesion of the lens to a holding pad during edging of the lens,” provides additional arguments against the Examiner’s rationale used at page 4 of the Action to support the current rejection. In particular, while Ohlin’s ink markings could potential adhere to its holding pad (*e.g.*, during a non-trimming state), Ohlin fails to disclose or suggest that ink markings “provide[s] sufficient adhesion” to hold the lens to the holding pad during trimming.

Applicant requests that the anticipation rejection be withdrawn for at least these reasons.

**F. The Anticipation Rejection in View of Lipman Should Be Withdrawn**

Claim 19 is rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,451,281 (“Lipman”). In particular, the Examiner relies on the embodiments described in Figures 5-8 of Lipman, where Lipman’s “LEAP pad 8 is superimposed over the opening 2 in the protective film 1, and the unitized film and pad are applied to the lens 7 as at the same time as a single unit.” Lipman at col. 5, lines 53-57. It appears that the Examiner is equating Lipman’s LEAP pad 8 with Applicant’s claimed temporary protective coating, and Lipman’s protective film 1 with Applicant’s peelable film.

Applicant respectfully disagrees for at least three reasons.

First, Applicant’s claim 19 states that the “peelable film electrostatically [adheres] to said outermost layer of the temporary protective coating.” By comparison, while Lipman’s protective film can optionally electrostatically adhere to the surface of the lens (col. 4, lines 56-57), it does not electrostatically adhere to LEAP pad. In this regard, Lipman plainly states that the LEAP pad has self adhesive on both its front and back surface (col. 2, lines 12-13; col. 6, lines 23-26). Therefore, the bond between Lipman’s LEAP pad and its protective layer is brought about by a self adhesive and not Applicant’s claimed electrostatic bond.

Second, Applicant’s claim 19 explains that the temporary protective coating includes “an outermost layer that is mechanically alterable through friction and/or contact.” Applicant’s specification provides the following definition for “mechanically alterable”:

Mechanically alterable through friction and/or contact according to the invention means a coating being removed after having been subjected to a dry wiping, consisting in 5 to and fro movements on the wiping area with a Wypall L40<sup>®</sup> cloth from the KIMBERLY-CLARK corporation, while maintaining a 3 kg/cm<sup>2</sup> pressure.

Specification at page 7, line 33, to page 8, line 4; col. 5, lines 57-61. By comparison, nothing in Lipman discloses or suggests that its LEAP pad has the above characteristics. If anything, the opposite is suggested given that the LEAP pad is made from “a high density butyl rubber material” (col. 2, lines 10-12). It is respectfully submitted that such rubber material would not be “removed after having been subjected to a dry wiping” as described in the above block-quoted passage.

Third, Applicant’s claim 19 explains that the temporary protective layer covers “the surface of the lens in such an amount that provides sufficient adhesion of the lens to a holding pad during edging of the lens.” By comparison, the Examiner states that Lipman’s LEAP pad is the temporary protective layer (Action at page 5). If so, then Lipman fails to disclose Applicant’s claimed “holding pad” that adheres to its claimed temporary protective layer. Stated another way, and in view of the Examiner’s rational for supporting the anticipation rejection, Lipman either discloses Applicant’s claimed temporary layer or its claimed holding pad but fails to disclose both. Indeed, Lipman fails to disclose the use of two LEAP pads when describing its edging process; this is not surprising as there is no apparent reason to redeposit a second LEAP pad made of a rubbery material onto an identical LEAP pad during the edging process. Such redundancy is simply not disclosed nor suggested in Lipman.

Applicant requests that the current anticipation rejection be withdrawn for at least the above-stated reasons.

#### G. The Obviousness Rejections Should Be Withdrawn

Claims 19-22, 25-32, and 38-43 are rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the combination of WO 03/057641 (“Conte”) in view of Lipman. The Examiner’s primary argument is:

It would be obvious to one of ordinary skill in the art to use the protective film of Lipman, over the coated lens of Conte, in order to ensure that the surface of the lens is protected during the edging operation. The opening in the film of Lipman allows the coating of Conte to provide its adhesion function while still protecting the rest of the lens surface.

Action at page 4.

Applicant respectfully disagrees with the above rationale for at least two reasons.

First, one of the primary themes of Conte is that its temporary protective coating serves a dual purpose. One, it provides “sufficient adherence at the interface holding pad/lens...” (page 8, lines 35-36). Two, as the namesake of Conte’s “temporary **protective** coating” suggests, it protects the underlying functional layers (*e.g.*, hydrophobic or oleophobic layers) lens during treatment and edging processes:

The temporary protective layer itself may have multiple layers, in particular two layers...[inorganic and organic]...The layer of an organic nature affords a good mechanical protection.... [page 6, line 32, to page 7, line 12]

The lenses are then put upside down and the convex side may be treated in a similar manner with no risk of alteration of the thin external hydrophobic/oleophobic layer of the concave side. After a recovery and a possible trimming of the lenses, the temporary protective layers are removed. If the protective layer is of a material increasing the surface energy of the external layer, it may be kept in favor [of] the acorn-positioning for the lens during the trimming operation. [page 10, lines 17-24].

Nothing in Conte discloses or suggests that its temporary protective coating is deficient in protection of the underlying coatings and lens substrate. If anything, the take-home message

upon considering Conte is that the temporary protective layer sufficiently performs its protection duties.

Given this, Applicant respectfully submits that the Examiner's rationale for combining Conte with Lipman fails. That is to say, there lacks a reasonable "apparent reason" *ala KSR* to apply Lipman's protective coating over Conte's protective coating for the purpose of protecting the lens. Why protect something that is already sufficiently protected? The use of a second protective coating in this instance is superfluous. Attached as Appendix A is a Declaration from Dominique Conte confirming this point. In addition to being a named inventor and employee of the assignee to the present application, Dominique Conte is also one of the inventors to the "Conte" reference that is being used to support the current obviousness rejection. Therefore, Dominique Conte has a thorough understanding of the protective capabilities of Conte's temporary protective coating.

Second, there appears to be a lack of a reasonable expectation of success that the use of Lipman's protective coating could be successfully implemented with the process disclosed in Conte. For instance, Conte explains that one of the purposes of its temporary protective coating is to protect an underlying functional layer (page 5, lines 28-31). Conte further explains the temporary protective layer should not be too thin or too thick, as either could result in damage to the underlying functional layer (page 6, lines 9-19).

The Examiner has proffered no arguments or evidence to suggest that application of Lipman's protective coating onto Conte's protective coating would not be destructive to Conte's underlying functional layers. While Applicant understands that the Examiner may not have access to a laboratory to confirm this, there should be no dispute that Conte warns against having a protective layer that is of a thickness that could potentially damage the underlying functional

layer. This warning in Conte provides an additional reason as to why a person having ordinary skill in the ophthalmic field would not have an apparent reason to employ Lipman's protective coating onto Conte's protective coating. This is especially true where, as here, the evidence of record suggests that Conte's protective coating works just fine on its own. If anything, it is likely that such a person would avoid using Lipman's coating in view of Conte's disclosure.

Applicant respectfully requests that the current obviousness rejection be withdrawn for at least the above-stated reasons.

#### **H. Dependent Claim 46 Is Separately Patentable**

Dependent claim 46 is separately patentable over the cited art. This claim recites:

The lens of claim 19, wherein the peelable film at least covers the center part of the temporary protective coating.

By comparison, one of the key features in Figures 5-8 of Lipman is that Lipman's protective coating 1 (which the Examiner equates with Applicant's peelable film) is designed to have an opening in its center to allow the lens block 5 come into contact with the LEAP pad 8.

This is illustrated in Figures 5 (with the dashed line representing the opening) and 7:

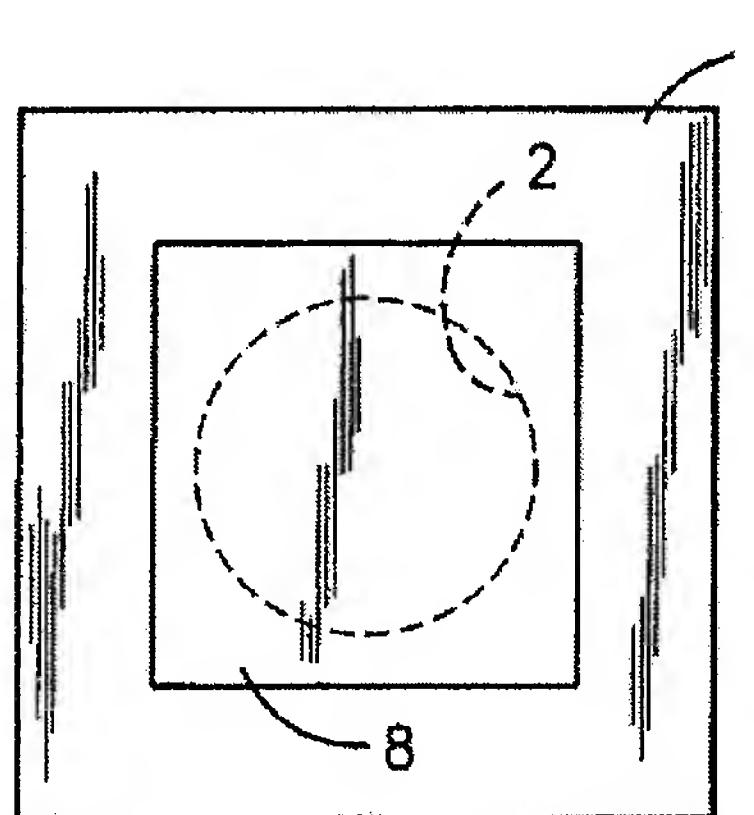


Fig. 5

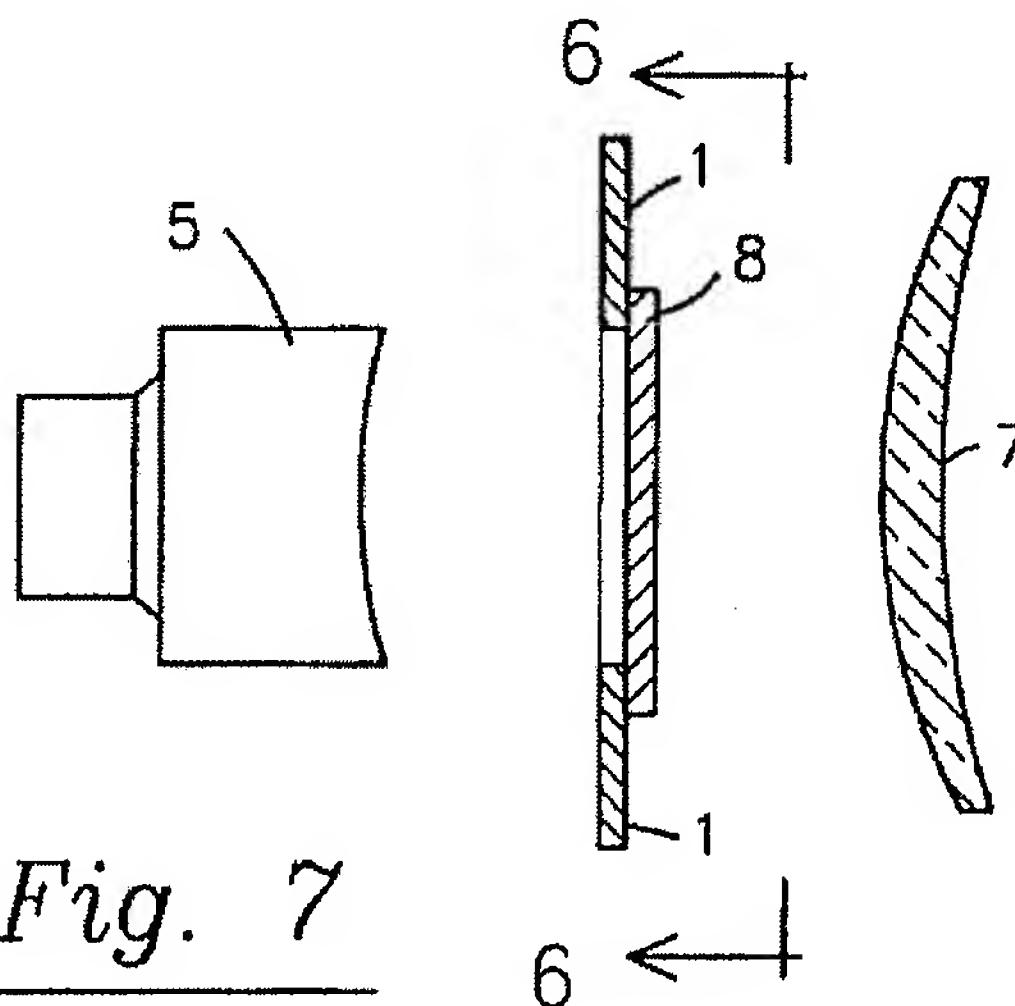


Fig. 7

Therefore, Lipman's protective coating 1 fails to cover the center part of the LEAP pad 8. If anything, it does the opposite by design.

Alternatively, if the Lipman protective coating 1 were used with the lens of Conte, the central part of the Conte lens would not be coated with the electrostatic film. As a result, the uncoated temporary protective coating of the lens would be damaged during storage, handling and transportation of the lenses in the central part of the lens (see the experimental part of Applicant's specification at pages 12-15). This would subsequently lead to adhesion loss between the lens and a holding pad and failure of the edging operation (see the Figures and page 5, lines 11-13, of Applicant's specification for coating of the central part of the lens with the temporary protective coating).

Applicant submits that dependent claim 46 is separately patentable for at least the above stated reasons.

## I. Conclusion

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512.536.3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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## **APPENDIX A**